

REMARKS

Claim Rejections

The Examiner has rejected claims 1-2, 4, 7-9, 12, 17-18 and 22-26 as being unpatentable under 35 U.S.C. § 103(a) over Figures 7a-7b (Camrud 7) of Camrud et al. (U.S. Patent No. 6,258,117) in view of Figures 5a-5b (Camrud 5) of Camrud et al. (U.S. Patent No. 6,258,117). The Examiner has also rejected claims 5, 10, 27-29, 32-35, 37 42-43 and 47 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in further view of Kocur (U.S. Patent No. 6,350,277). The Examiner has also rejected claims 19 and 44 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in view of Kocur in further view of Hong et al. (U.S. Patent No. 6,565,599). The Examiner has also rejected claim 3 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in further view of Evans et al. (U.S. Patent No. 6,102,938). The Examiner has also rejected claims 13-14, 16, 38-39 and 41 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in view of Kocur in further view of Wu et al. (U.S. Patent No. 6,254,632). The Examiner has also rejected claims 6, 11, 15, 31, 36 and 40 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in view of Kocur in view of Wu et al. in further view of Sirhan et al. (U.S. Patent No. 7,077,859). The Examiner has also rejected claims 20-21 and 45-46 as being unpatentable under 35 U.S.C. § 103(a) over Camrud 7 in view of Camrud 5 in view of Kocur in further view of Camrud et al. (U.S. Patent No. 6,485,510). The Examiner has also rejected claims 48-50 as being unpatentable under 35 U.S.C. § 103(a) over Camrud '510 in view of Camrud 5.

Applicants have carefully considered the Examiner's comments. In order to expedite prosecution of Applicants' claims, Applicants have cancelled claims 1-29 and 31-47. Applicants have also amended claims 48 and 50 to further clarify the claims. Applicants have also added new claims 51-76. Applicants respectfully submit that the prior art of record does not disclose all of the limitations of Applicants' claims as presented. Moreover, there is no suggestion or motivation to combine or modify the prior art to achieve Applicants' claimed inventions.

Claims 48 and 50 stand rejected based upon Camrud '510 and Camrud 5. In particular, the Examiner argues that Camrud '510 discloses a connector member (215) that is curved and is elongate and extending across a space separating adjacent ring structures. The Examiner admits, however, that the connector member (215) which is disclosed in Camrud '510 is not biodegradable. Instead, the Examiner relies upon Camrud 5 to argue that it would have been obvious to modify the connector member (215) to make it biodegradable because Camrud 5 discloses ring structures that are joined by a biodegradable connector member (90).

In order to further distinguish the prior art, Applicants have amended claim 48 to clarify that the curved connector member extends across a space separating adjacent ring structures and that the entire length of the connector member is biodegradable. Claim 50 has been amended to clarify that the entire length of the connector member is biodegradable. Camrud '510 and Camrud 5 fail to disclose these limitations because neither Camrud reference discloses an elongate biodegradable connector member that extends across a space separating adjacent ring structures. The Examiner does not appear to dispute this contention. As the Applicants understand the Examiner's position, the Examiner appears to be arguing that it would be obvious to change the connector member (215) disclosed in Camrud '510 to make the entire connector member (215) biodegradable. However, the Examiner's modification of Camrud '510 would change the principle of operation of Camrud '510. Moreover, Camrud '510 teaches away from this modification.

The connector member (215) disclosed in Camrud '510 is made from Nitinol, which is not a biodegradable material. (Camrud '510 at col. 13, lines 64-65). The connector member (215) is designed to physically separate at particular locations, such as at the vertex of the two rods 220, 225 as shown in Figure 27 or at the connections to the stent sections 205 as shown in Figure 26. (Col. 14, lines 41-52). The purpose of the connector member 215 is to "provide a stabilizing function for the separated stent sections by acting as leverage against tumbling." (Col. 15, lines 13-15).

The Examiner's combination of Camrud '510 and Camrud 5 is improper because even if Camrud '510 and Camrud 5 are combined, the proposed combination would still not achieve all of the limitations of Applicant's claims. As noted above, neither of the

Camrud references disclose a biodegradable connector member that is elongate and extending across a space separating adjacent ring structures, where the entire connector member is biodegradable.

If Applicants correctly understand the Examiner's position (that the **non-biodegradable** connector (215) disclosed in Camrud '510 could be changed to make it **biodegradable**), this proposed modification is clearly derived from impermissible hindsight. First, the Examiner's proposed modification would change the principle of operation of Camrud '510. MPEP § 2143.01 (VI. THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE). As explained above, Camrud '510 teaches that the connector member (215) is made from a non-biodegradable material, not a biodegradable material. Non-biodegradable and biodegradable materials are entirely different from each other, and one of ordinary skill in the art would not consider non-biodegradable materials and biodegradable materials to be readily substitutable for each other. Indeed, non-biodegradable and biodegradable materials are more appropriately described as opposites of each other. Therefore, the Examiner's proposed modification would improperly change the principle of operation of Camrud '510 by changing the disclosed material of the connector member (non-biodegradable) to a material that is the opposite of the disclosed material (biodegradable).

Second, Camrud '510 specifically teaches away from the Examiner's proposed modification of the disclosed connector member (215). As noted above, the connector member (215) disclosed in Camrud '510 is designed to stabilize the stent segments (205) within the artery. This prevents the stent segments from tumbling within the artery. (Col. 15, lines 16-18). Thus, Camrud '510 teaches that it is necessary to make the connector member (215) from a non-biodegradable material. Therefore, the Examiner's modification goes against the teaching of Camrud '510 because Camrud '510 teaches that it is desirable to make the connector member (215) from a non-biodegradable material so that the connector member (215) can stabilize the stent segments (205).

Accordingly, because there is no suggestion or motivation to modify Camrud '510 to make the entire length of an elongate connector member biodegradable, claims 48

and 50 are allowable as presented. The prior art of record also fails to disclose the additional limitations of dependent claims 49 and 51-76. Because each of these claims incorporate all of the limitations of allowable claims 48 and 50 from which they respectively depend, claims 49 and 51-76 are also allowable. Therefore, any further arguments that could be made at this time in support of the additional limitations of Applicants' dependent claims would be superfluous and unnecessary. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988); *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983).

Conclusion

In response to the Examiner's comments, Applicants have amended claims 48 and 50. Applicants have also cancelled claims 1-29 and 31-47 and have added new claims 51-76. It is respectfully submitted that none of the prior art of record discloses all of the limitations of the claims as now presented. In particular, the prior art does not disclose a biodegradable connector member that is elongate and extends across the space between adjacent ring structures, where the entire length of the connector member is biodegradable. Moreover, there is no suggestion or motivation to combine or modify the prior art to achieve Applicants' claimed inventions. Therefore, Applicants' claims are allowable. Accordingly, Applicants request reconsideration and allowance of the application.

Respectfully submitted,

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